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EXAMINER

BROWN, JENNINE M

ART UNIT PAPER NUMBER

1755

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/523,828

Applicant(s)

JACOBSEN ET AL.

Examiner

Jennine M. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 4-15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/8/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Objections

Claim 3 is objected to because of the following informalities:

"tetraisobutylaluminumoxane" is not proper because the valence of aluminum does not support a fourth carbon moiety around the central aluminum atom, therefore examiner assumes applicant meant to claim "tetraisobutyldialuminumoxane". Appropriate correction is required.

Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim and should refer to other claims in the alternative only. See MPEP § 608.01(n).

Accordingly, claim 4 has not been further treated on the merits.

Claims 5-7 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim and should refer to other claims in the alternative only. See MPEP § 608.01(n). Claims 6 and 7 depend on an improper multiple dependent claim. Accordingly, claims 5-7 have not been further treated on the merits.

Claims 8-10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim and should refer to other claims in the alternative only. See MPEP § 608.01(n). Claims 9 and 10 depend on an improper multiple dependent claim. Accordingly, claims 8-10 have not been further treated on the merits.

Claim 11 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim and should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, claim 11 has not been further treated on the merits. Claim 11 is also objected to because it depends from a claim having a different statutory category (method of making a product, method of using said product) which is improper.

Claims 12-13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim and should refer to other claims in the alternative only. See MPEP § 608.01(n). Claim 13 depends on an improper multiple dependent claim. Accordingly, claims 12-13 have not been further treated on the merits.

Claims 14-15 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim and should refer to other claims in the alternative only. See MPEP § 608.01(n). Claim 15 depends on an improper multiple dependent claim. Accordingly, claims 14-15 have not been further treated on the merits.

Claims Analysis

Any component claimed as optional will be deemed as not present in the instant claims. Should applicant prefer to include said component, the claim should be claimed to directly include said limitations rather than indirectly include said limitations.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor, et al. (US 6774079 B1) in view of Saudemont, et al. (US 6605561 B1).

See entire disclosure. Taylor, et al. disclose a method for the preparation of a supported transition metal catalyst system (col. 4, l. 35-48) comprising the steps of mixing together in a solvent, aluminum alkyl, ionic activator, support material and transition metal compound. Taylor, et al. specifically disclose that the support is a silica support (col. 3, l. 66-col. 4, l. 10), that the ionic activator is an alkylammonium tris(pentafluorophenyl)(4-hydroxyphenyl)borate (col. 3, l. 46-49), metallocene compound (col. 2, l. 32-50) and an organoaluminium compound is triisobutylaluminum (col. 3, l. 57-63). Taylor, et al. fail to fairly teach or suggest tetraisobutyldialuminoxane. Saudemont, et al. cures this deficiency by disclosing that

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tetraisobutyldialuminoxane is a known co-catalyst in metallocene catalyst systems (col. 4, l. 30-31). It would have been obvious to one of ordinary skill in the art to add a co-catalytic compound such as tetraisobutyldialuminoxane in order to activate the metallocene and increase the efficiency of the polymerization.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 16-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending US Application 10/524730. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a method for the preparation of a supported transition metal catalyst system comprising mixing an

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organometallic compound (metallocene), ionic activator, support material, transition metal compound in suitable solvent wherein the organic compound is an organoaluminum compound, preferably triisobutylaluminum.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

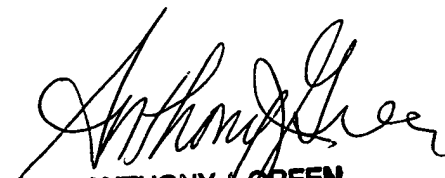
Claims 1-3 and 16-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent 6818712 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a method for the preparation of a supported transition metal compound comprising mixing together an organometallic compound (trialkylaluminum), ionic activator (bis(hydrogenated tallow alkyl)methyl ammonium tris(pentafluorophenyl)(4-hydroxyphenyl)borate), support material (silica) and metallocene. The instant claims are an improvement over the patented claims because a co-catalyst is added to decrease the catalyst induction time, thus increasing the efficiency of the catalyst.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (571) 272-1364. The examiner can normally be reached on M-R 9:30 AM - 7:30 PM; Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jmb



ANTHONY J. GREEN
PRIMARY EXAMINER